

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated January 15, 2004, indicated that the Specification is objected to; claim 20 is rejected under 35 U.S.C. § 112(2); claims 1-9, 13, 14 and 20 are rejected under 35 U.S.C. § 103(a) over *Edholm* (U.S. Patent No. 6,449,269) in view of teaching in the art; claim 10 is rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Bertin* (U.S. Patent No. 6,097,243); claim 11 is rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Mason* (U.S. Patent No. 6,272,451); claims 12 and 15-18 are rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Maeda* (U.S. Patent No. 5,884,074); claim 19 is rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Blomley* (U.S. Patent No. 4,608,462); and claims 21-23 are rejected under 35 U.S.C. § 103(a) over *Edholm* and teaching in the art and further in view of *Adelman* (U.S. Patent No. 5,598,362).

Regarding the alleged lack of support for the subject matter of claims 4, 13, 15 and 20, Applicant respectfully traverses the objection to the Specification because pursuant to 35 U.S.C. § 112, the claims are considered part of the specification. Thus, claim language is part of the Specification. The Board of Patent Appeals and Interferences has held that a claim must be reasonably ascertainable to one skilled in the art, and the MPEP further explains that, with respect to either the claims or the disclosure, word-for-word correspondence is not a requirement for claim language. *See, e.g.*, MPEP § 2173.05(e). Thus, the Specification is therefore inherently in line with claims 4, 13, 15 and 20 because claims 4, 13, 15 and 20 are part of the Specification. Moreover, at least FIGs. 11 and 12 address the microphone, telephony communication device, audio capture device and audio speaker of claims 4 and 13, for example, in connection with the illustrated telephone and telephone handset. With respect to claim 15, at least FIGs. 2 and 6 include a flash cache. FIG. 11 shows examples of a telephony network by which the skilled artisan would understand that a plurality of telephony devices would also connect to the network system in the same manner. Each of the figures is described in the Brief Description of Drawings section of the Specification. Moreover, the

Specification describes various example embodiments that may be applied to the figures and including, for example, discussion of network applications in connection with page 13, lines 7-17. In addition, various other portions of the Specification discuss applicability to network telephony. Those figures not specifically discussed in the Detailed Description are further examples of the previously detailed figures. Thus, Applicant's Specification is in compliance with 35 U.S.C. §112 and no further support should be necessary.

With respect to the Section 112(2) rejection of claim 20, Applicant respectfully traverses because the claimed subject matter is clearly ascertainable by the skilled artisan. Claim 20 is directed to a network including a plurality of telephony devices, a CPU, and a communications link. As indicated by the length and positioning of the indentation of claim 20, the skilled artisan would recognize that the CPU is outside the telephony devices and another aspect of the claimed network.

Applicant respectfully traverses the Section 103(a) rejections, all of which rely upon the '269 reference as a primary reference, because the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, as indicated in the M.P.E.P., the reference (or references) must teach all of the claim limitations and there must be some suggestion or motivation to modify the primary reference or to combine reference teachings. In this instance, the Office Action failed to meet all of the criteria for establishing such a Section 103(a) rejection, as discussed below.

Regarding the assertion in the Office Action that the '269 reference teaches an ASIC, Applicant submits that the Office Action has failed to adequately point out those portions of the '269 reference being asserted as a "programmable audio processor chip" and requests clarification. Specifically, the portion of the '269 reference cited in support of teaching for an ASIC (col. 13, lines 15-17) refers to claim 4. No other portion of the '269 reference was cited in support of such an ASIC. In addition, Applicant has reviewed the '269 reference and cannot ascertain any further discussion, enabling or otherwise, of an ASIC and its application to the claimed invention. Therefore, it is unclear as to how the claimed specific "ASIC" of the '269 reference would apply to the programmable (and reprogrammable) chip of the instant invention. Moreover, the Office Action failed to offer any rationale as to how the claimed ASIC of the '269 reference

would function as the programmable chip of the instant invention. Should the rejection be maintained, Applicant requests clarification and an opportunity to respond thereto.

Applicant further submits that the primary '269 reference does not teach, as asserted in the Office Action, a programmable audio processor chip in the context of the claimed invention. Specifically, the discussion of an application-specific integrated circuit (ASIC) in the '269 reference does not teach, as suggested in the Office Action, a "programmable audio processor chip" in the context of the claimed invention (and as applicable to all claims). An ASIC is a microchip designed for a special application, such as a particular kind of transmission protocol or a hand-held computer. In this instance, the '269 reference simply states in claim 4 that certain components may be housed in an ASIC; no further support for such an ASIC implementation can be found in the specification of the '269 reference. Moreover, upon further review of the '269 reference, the claimed ASIC implementation in the '269 reference appears limited in application to a grouping of components that have a dedicated function that includes voice processing using a predetermined compression technique (*see, e.g.*, column 6, lines 1-13). The '269 reference does not appear to teach or suggest, for example, a processor capable of processing various types of compressed data as programmed (and reprogrammed).

In addition, various other claimed limitations are not explicitly taught or suggested in the '269 reference. For example, the '269 reference fails to teach, and the Office Action fails to assert, that the extractor 322 (asserted as part of an "IP network stack") would be included on the claimed ASIC. Furthermore, the Office Action failed to show how a DSP could be integrated with the asserted ASIC of the '269 reference, and how the memory in the '269 reference would support such an integration. Regarding the dissipation limitations in claim 9, the Office Action has failed to show any teaching or suggestion of these limitations, or how the '269 reference could function, as described or as modified with the DSP, to dissipate as claim 9 is directed.

Regarding claim 20, Applicant submits that the Office Action has improperly asserted that the controller 314 of the '269 reference (asserted here to be both a "CPU" and the "audio processing circuitry") would program the programmable audio processor chip. Specifically, the Office Action first asserts on page 11 that the controller 314 is "audio processing circuitry" of an IP telephony device, and then further asserts that the same controller 314 is now a CPU that programs the (external) IP telephony device. It is

unclear as to how the controller 314 could function both as the claimed audio processing circuitry of an IP telephone and as a CPU adapted to communicate with the IP telephone (e.g., as shown in FIG. 11 of the instant application). Applicant therefore submits that the Office Action's assertion is untenable, confusing and accordingly fails to teach or suggests the limitations in claim 20. Moreover, Applicant has reviewed the cited portions (and other portions) of the '269 reference and cannot ascertain where the controller 314 would be programmable by a CPU as claimed.

Applicant also submits that the Section 103 rejections failed to adequately cite evidence of motivation for modifying the primary '269 reference. For example, as acknowledged on page 4 of the Office Action, the '269 reference fails to teach or suggest the DSP of the claimed invention. In an attempt to arrive, in hindsight, at the claimed limitations of the instant invention, the Examiner has asserted that such a DSP is "well known" and that "a chip can be designed to include DSP voice compression." However, the Office Action failed to include any evidence from the prior art in support of these allegations. The Office Action further failed to cite any evidence of how such an integrated DSP would function in connection with the '269 reference as apparently combined with the ASIC briefly mentioned in claim 4. The Office Action also failed to discuss the combination of extractor 322 onto ASIC of claim 4. Moreover, the combination of the extractor 322 onto the ASIC does not appear to be supported in the specification of the '269 reference because the specification fails to discuss the ASIC outside of the brief mention in claim 4 itself. This combination of the extractor 322 onto the ASIC would be necessary were the "IP network stack," as asserted in the Office Action to include the extractor 322, integrated onto the ASIC.

Regarding claim 12, Applicant further submits that the Office Action failed to show how the memory of the '269 reference would function with flash-cache architecture as claim 12 of the instant application is directed. For instance, as discussed above, the '269 reference appears to be limited to a specifically programmed chip (ASIC) that processes data compressed using a predefined compression technique. The Office Action has failed to show how one of skill in the art would be motivated to modify and reprogram the application-specific programmed controller 314 of the '269 reference with new, external programming via the flash-cache architecture.

In view of the above, Applicant submits that the Office Action failed to cite teaching or suggestion of all of the claimed limitations and further failed to cite evidence of motivation for modifying the primary '269 reference. Therefore, the Office Action failed to establish a *prima facie* case of obviousness and the Section 103 rejections should be removed.

As discussed above, please find attached hereto a Petition for Extension of Time. Should any additional fees be necessary or should any overages exist, authorization is hereby provided to charge/credit Deposit Account number 50-0996 (8X8S.243PA).

In view of the above discussion, Applicant believes that the rejection has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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